

Procter & Gamble – I.P. Division**IMPORTANT CONFIDENTIALITY NOTICE**

The documents accompanying this telecopy transmission contain confidential information belonging to the sender which is legally protected. The information is intended only for the use of the individual or entity named below. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone (collect) to arrange for return of the telecopied document to us.

**BEST AVAILABLE COPY FACSIMILE TRANSMITTAL SHEET AND
CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8****RECEIVED
CENTRAL FAX CENTER****MAR 31 2005****TO: Commissioner of Patents - Mail Stop Appeal Brief –
United States Patent and Trademark Office**

Fax No. 703-872-9306

Phone No. 703-305-3712

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on March 31, 2005, to the above-identified facsimile number.

Teresa A. Wert (Signature)

FROM: Teresa A. Wert (Office of Jay A. Krebs)

Fax No. 513-634-3007

Phone No. 513-634-3114

Listed below are the item(s) being submitted with this Certificate of Transmission:**

- 1) Appeal Brief Transmittal (Orig. & Copy)
- 2) Appeal Brief (Orig. - 18 pgs.)
- 3)
- 4)
- 5)

Number of Pages Including this Page: 21

Inventor(s): Nabil Enrique Salman et al.

S.N.: 09/745,702

Filed: December 21, 2000

Docket No.: 8384Comments:

**Note: Each paper must have its own certificate of transmission, OR this certificate must identify each submitted paper.

Certification of Mailing or Facsimile Transmission
I hereby certify that I have reasonable basis to expect that, on the date shown below, this correspondence is being submitted as indicated below:
[] mailed or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450
[X] facsimile transmitted to the U.S. Patent and Trademark Office via fax number (703) 872-9306

Teresa A. Wert
Name
Teresa A. Wert
Signature
March 31, 2005
Date

RECEIVED
CENTRAL FAX CENTER
MAR 31 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/745,702
Applicant(s) : Nabil Enrique Salman et al.
Filed : December 21, 2000
Title : Portable Packaging Device And Method For Forming
Individually Packaged Articles
TC/A.U. : 3721
Examiner : Thanh K. Truong
Conf. No. : 9701
Docket No. : 8384
Customer No. : 27752

TRANSMITTAL LETTER FOR APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir,

Enclosed with this transmittal letter is an Appeal Brief for the above-identified application pursuant to 35 CFR 1.192. Please charge the fee of \$500.00 pursuant to 37 CFR 1.17 to Deposit Account 16-2480. The Commissioner is also authorized to charge any additional fees which may be required to this Account No. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY


Signature


Jay A. Krebs

Registration No. 41,914

(513) 634-4856

Date: March 31, 2005

Customer No. 27752

<small>Certification of Mailing or Facsimile Transmittal</small>	
<small>I hereby certify that I have reasonable basis to expect that, on the date shown below, this correspondence is being submitted as indicated below:</small>	
<small>() mailed or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450</small>	
<small>(X) facsimile transmitted to the U.S. Patent and Trademark Office via fax number (703) 872-9306</small>	
<small>Teresa A. Wey</small>	<small>Name</small>
	<small>Signature</small>
<small>March 31, 2005</small>	<small>Date</small>

RECEIVED
CENTRAL FAX CENTER
MAR 31 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


Application No.	:	09/745,702
Applicant(s)	:	Nabil Enrique Salman et al.
Filed	:	December 21, 2000
Title	:	Portable Packaging Device And Method For Forming Individually Packaged Articles
TC/A.U.	:	3721
Examiner	:	Thanh K. Truong
Conf. No.	:	9701
Docket No.	:	8384
Customer No.	:	27752

TRANSMITTAL LETTER FOR APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
Dear Sir,

Enclosed with this transmittal letter is an Appeal Brief for the above-identified application pursuant to 35 CFR 1.192. Please charge the fee of \$500.00 pursuant to 37 CFR 1.17 to Deposit Account 16-2480. The Commissioner is also authorized to charge any additional fees which may be required to this Account No. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY




Signature
Jay A. Krebs

Registration No. 41,914
(513) 634-4856

Date: March 31, 2005

Customer No. 27752

Certification of Mailing or Facsimile Transmission I hereby certify that I have reasonable basis to expect that, on the date shown below, this correspondence is being submitted as indicated below: <input type="checkbox"/> mailed or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 <input checked="" type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office via fax number (703) 872-9306	
Thomas A. Wort Name	 Signature
March 31, 2005 Date	

RECEIVED
CENTRAL FAX CENTER
MAR 31 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/745,702
Applicant(s)	:	Nabil Enrique Salman et al.
Filed	:	December 21, 2000
Title	:	Portable Packaging Device And Method For Forming Individually Packaged Articles
TC/A.U.	:	3721
Examiner	:	Thanh K. Truong
Conf. No.	:	9701
Docket No.	:	8384
Customer No.	:	27752

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450
 Dear Sir,

This Brief is filed pursuant to the appeal from the U.S. Patent and Trademark Office decision of Paper no. 10212004. A timely Notice of Appeal was filed on February 1, 2005.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

An appeal brief for U.S. Application Serial No. 10/010,391, filed on December 7, 2001, was filed on February 4, 2005. U.S. Application Serial No. 10/010,391 is a continuation in part of the application at bar.

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

STATUS OF CLAIMS

Claims 1 and 6-10 are rejected and are appealed. Claims 2-5 and 11 are cancelled. Claims 12-20 are withdrawn from consideration. A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

STATUS OF AMENDMENTS

No claim amendments were made after the Final Rejection by the Office.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to a portable packaging device for manually packaging articles within a flexible tubular sheet. (page 2, lines 53-54). With regard to claim 1, the portable packaging device (item 10, Figures 1, 2, and 3) comprises an inlet end (item 12, Figure 2) and an outlet end (item 13, Figures 1 and 3). (page 2, lines 54-55). The portable packaging device further comprises a body (item 20, Figure 2) formed by an inner core (item 22, Figure 2) having an inlet opening (item 23, Figures 1 and 2) and an outlet opening (item 24, Figure 2), and a passageway (item 25, Figure 2) there between for passing there through an article (item 100, Figure 3) to be packaged. (page 3, lines 94-99).

The portable packaging device further comprises a casing (item 14, Figure 2) which comprises a surrounding casing wall (item 16, Figures 1-2) and a base wall (item 18, Figure 2) that joins an end of the surrounding casing wall to the body. (page 4, lines 107-108). The body and the casing define a storage space (item 30, Figure 2) and a dispensing opening (item 32, Figure 2) at the inlet end, wherein the device retains a length (item 50, Figure 2) of a flexible tubular sheet within the storage space. (page 4, lines 109-111).

The tubular sheet is dispensed through the dispensing opening and into the inlet opening of the inner core. (page 4, lines 110-112; page 12, lines 397-398; Figure 2). The article to be packaged can be inserted through the inlet opening, and inside the tubular sheet. (page 12, line 401). The tubular sheet is gathered and closed at each end to form a closed packaged article (item 105, Figure 3). (page 12, lines 399-402).

The tubular sheet has an outer surface which faces inward when the tubular sheet is passed through the inner core. (page 6, lines 179-180; Figure 2). The outer surface of

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

the tubular sheet comprises an adhesive material. (page 6, lines 178-179). The adhesive on the outer surface of the tubular sheet allows a leading portion (item 52, Figure 2) and a trailing portion (item 62, Figure 2) of the tubular sheet to be closeable on each side of article, thereby forming the closed packaged article. (page 6, 182-184). A cutting blade (item 74, Figures 1 and 3) positioned adjacent the outlet opening of the inner core, can cut through the trailing portion of the tubular film to form the closed packaged article. (page 14, lines 457-460).

Claim 10 pertains to a portable packaging device (item 100, Figures 1A and 1B) which comprises all of the same claim elements of claim 1. However, an outlet opening (item 24, Figures 1A and 1B) and a portion of the passageway (item 25, Figure 1B) of the portable packaging device of claim 10 are oval or elliptical. (page 3, lines 99-100).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Claims 1 and 6-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et al., hereafter "Richards", in view of U.S. Patent No. 5,662,758 issued to Hamilton et al., hereafter "Hamilton", and U.S. Patent No. 3,111,796 issued to W.E. Meissner, hereafter "Meissner".

ARGUMENTS

- I. **Claims 1 and 6-9 have been improperly rejected under § 103(a) over Richards in view of Hamilton and Meissner.**
- A. The Office has failed to establish a *prima facie* case of obviousness against the claimed invention.

It is well established that in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP § 706.02(j) at 46 (8th ed., rev. 2, May 2004). First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *See In re Royka*, 490 F.2d 981, 985, 180 USPQ 580 (CCPA 1974). The Federal Circuit has stated that "the examiner bears the initial burden,

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443 (Fed. Cir. 1992).

The Office, in Paper no. 10212004, states:

Richards discloses an apparatus comprising: a body formed by an inner core having an inlet opening and an outlet opening and a passageway there between (figures 1, 4 & 5); a casing 1 comprising a surrounding casing wall, a storage space to retain a length of the flexible tubular sheet 2 within the storage space in a layered stack; the tubular sheet is gathered and closed at each end to form a closed packaged article 35 (figure 1); a means 61 comprises a slot for separating the closed packaged article; and the cutting blade 64 (figure 6)....

W. E. Meissner discloses, in an invention for closing and sealing a container, that: 'for closing and sealing a collapsible container by rupturing a bubble of tacky film-forming material at least within the opening end of the container as that portion of the container is urged into collapsed position' (column 1, lines 31-35). Figure 5 further depicting the closing and sealing of a flexible bag by twisting the bag at the area 53. During this twisting operation, the bubble ruptured and coated the inner wall of the bag with adhesive (column 5, lines 48-55).

Hamilton discloses a flexible film having pressure sensitive adhesive protected from inadvertent adherence (abstract); the flexible film having a recessed pressure sensitive adhesive and collapsible protrusions (three-dimensional film) which serve as stand-offs to prevent premature sticking to wide variety of rigid and resilient target surfaces, wherein the collapsible protrusions are small and closely spaced for releasable sealing of the composite material to such surfaces or even to itself (column 3, lines 20-26).

W E. Meissner's teaching provides a motivation for the practitioner in the art to find a flexible material to use as a bag in which the inner surface is coated with adhesive, and when pressure is applied such as twisting, the adhesive material ensures the sealing of the closure of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Richards' tubular sheet by applying the flexible film with adhesive as taught by Hamilton providing an effective closing and sealing of the waste article in which the flexible material having pressure

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

sensitive adhesive that is protected from inadvertent adherence to other surfaces.

(Paper no. 10212004 pages 2-4).

1. There is no motivation to combine the cited references because the cited references teach away from the suggested combination.

- a. Combination of Richards and Meissner

A reference teaches away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. See *United States v. Adams*, 383 U.S. 39, 52 (1966). If a reference is found to teach away from a suggested combination, then there is no motivation to make the suggested combination. See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

The Office asserts that Meissner provides a motivation to add an adhesive to a flexible material to insure the sealing and the closure of the flexible material. However, Richards recommends measures to ensure the sealing and closing of the flexible material without the use of adhesives. Richards teaches that a top of a pleated tubing is pulled upward and tied into a knot thereby forming a bottom of a package. (col. 3, lines 11-14). Richards further teaches that after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Richards also teaches the use of high density polyethylene in order to tightly maintain knots that are created. (col. 3, lines 55-60). Moreover, Richards teaches that "[e]ven if the twisted seals between the packages become loosened, the lid and the newly formed topmost twisted seal will prevent the escape of odours, vapours, and gases to the ambient atmosphere." (col. 3, lines 54-57).

Because Richards discloses several means of maintaining a tight seal or closure, one skilled in the art, after reading Richards, would be discouraged from utilizing adhesive in sealing or closing the pleated tubing of Richards. Consequently, there is no motivation to combine the suggested references.

- b. Combination of Richards and Hamilton

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

In an Office Action dated May 20, 2004, (hereafter "Paper no. 05142004") the Office asserted that "it would have been obvious to one of ordinary skill in the art... to modify Richards' tubular sheet by applying the flexible film with adhesive as taught by Hamilton." (Paper no. 05142004 page 6). However, similar to the above suggested combination, there is also no motivation to combine these suggested references.

As discussed above, Richards teaches several methods for sealing the pleated tubing. For example, Richards teaches that even if the intermediate twisted seals become loose, the topmost twisted seal prevents odours from escaping. (col. 3, lines 54-60). Furthermore, Richards recommends the use of high density polyethylene because joints that are created using this material remain tight. *Id.*

In contrast, Hamilton teaches a composite material which is capable of contacting a target surface without sticking. (Abstract). Hamilton teaches that when collapsible protrusions of the composite material are pressed they collapse such that a pressure sensitive adhesive is exposed to a target surface. (cols. 4-5, lines 65-67; 1-2). Because one skilled in the art would be inclined to use the sealing methods taught in Richards rather than using the composite material of Hamilton, Richards teaches away from the use of the composite material of Hamilton. Because Richards teaches away from using the composite material of Hamilton, there is no motivation to combine the cited documents.

2. There is no motivation to combine the cited references because the suggested combination of references would render the primary reference unsatisfactory for its intended purpose.

The Federal Circuit has held that it is an error to consider prior art references in less than their entirety such that portions of the prior art references that "diverge from and teach away from the invention at hand" are disregarded. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303 (Fed. Cir. 1983). Furthermore, the Federal Circuit has held that where a proposed modification would render a prior art invention "inoperable for its intended purpose," the prior art reference, in effect, teaches away from the proposed modification. *In re Gordon*, 733 F.2d 900, 901, 221 USPQ 1125 (Fed. Cir. 1984).

While the Office asserts that Meissner provides a motivation to add adhesive to a flexible material to ensure closing and sealing of the flexible material, the Office does not

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

take into account the teachings of Meissner with regard to how the adhesive is applied to the flexible material. Meissner teaches the addition of adhesive to insure the sealing and closure of a container via complex machines and processes. Meissner teaches that in order to insure sealing and closure of a container, an adhesive "is suspended within the open end of a container, expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed." (col. 2, lines 3-6). Meissner further teaches that "[c]ontrol over the areas of the container walls coated with the adhesive film-forming material may be achieved by selectively positioning the expanded bubble or bubbles of film-forming material relative to the open end of the container." (col. 2, lines 30-34). A mechanical device is required to suspend the adhesive within the open end of the container, and another mechanical device may be necessary to expand the adhesive into the form of a bubble.

However, an expressed objective of Richards is to avoid complicated mechanical devices. (col. 1, lines 47-49). Therefore, the addition of adhesive to insure the sealing and the closure of the flexible material of Richards via the process disclosed in Meissner would greatly complicate the sealing and closure of the flexible material as disclosed in Richards. Thus, the addition of adhesive to seal or close the flexible material of Richards via Meissner would contravene the intended purpose of Richards. Consequently, Richards, in effect, teaches away from the suggested combination with Meissner. Therefore, there is no motivation to combine Richards with Meissner.

3. The combination of cited references fail to teach or suggest all of the claim limitations of the claimed invention.

Even assuming *arguendo* that there is motivation to combine the suggested references, the suggested combination still fails to teach or suggest all of the claim limitations of the claimed invention. Claim 1 recites, in part, that a cutting blade is "positioned adjacent the outlet opening of the inner core, for cutting through a trailing portion of the tubular film to form the closed packaged article."

In contrast, Richards teaches that "[w]hen it is desired to remove the packages from the bin portion 36 for transport to a waste disposal facility, the uppermost package is severed... above its upper twisted closure 30." (col. 3, lines 48-52). In addition, Richards teaches that a cutter unit 61 is disposed on a lid 31. (col. 4, lines 10-15; Figure 6). The lid 31 is positioned near an inlet opening of the packaging device of Richards.

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

Consequently, Richards does not teach that a cutting blade is "positioned adjacent the outlet opening of the inner core, for cutting through a trailing portion of the tubular film to form the closed packaged article", as is recited, in part, in claim 1. Moreover, neither Hamilton nor Meissner teach this element of claim 1.

B. The Office has failed to establish a by a preponderance of the evidence that a *prima facie* case of obviousness is more probable than not.

The Federal Circuit has stated that "[a]fter evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443 (Fed. Cir. 1992). Regarding the statement by the Federal Circuit in *Oetiker*, the MPEP provides that "[w]ith regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the reference teachings establish a *prima facie* case of obviousness) is more probable than not." MPEP §2142 at 129.

As shown above, there is no motivation to combine the suggested references because Richards teaches away from the suggested combination. Furthermore, the suggested combination of references would render Richards unsatisfactory for its intended purpose. Also, the suggested combination of references fails to teach or suggest all of the claim limitations of claim 1 and claims 6-9, which depend from claim 1. Therefore, the Office has failed to establish a *prima facie* case of obviousness. Consequently, the Office has not shown by a preponderance of evidence that a *prima facie* case of obviousness is more probable than not.

For the foregoing reasons, the Office has failed to establish a *prima facie* case of obviousness against claim 1. Consequently, the Office has also failed to establish a *prima facie* case of obviousness against claims 6-9, which depend from claim 1.

II. Claim 10 has been improperly rejected under § 103(a) over Richards in view of Hamilton and Meissner.

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

A. The Office has failed to establish a *prima facie* case of obviousness against the claimed invention.

1. The Office has not met its initial burden of establishing a case of *prima facie* obvious.

The MPEP provides that "35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references." § 706.02(j) at 46. Moreover, the MPEP provides that "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." § 2142 at 128.

The Office, in Paper no. 10212004, states that:

Regarding to claim 10, the modified Richards discloses the claimed invention, but does not expressly disclose that the shape of the outlet opening and a portion of the passageway are oval.

It would have been an obvious matter of design choice to make the outlet opening and a portion of the passageway in an oval shape.

Since Applicant's disclosure submitted that the shape of either or both the inlet and outlet opening can be circular, or oval (page 4, lines 14-16), therefore, the apparatus of the present invention would perform equally well with the outlet opening of a circular- shape. Thus, the oval shaped outlet opening would have been an obvious variation of the present invention.

(Paper no. 10212004, page 4).

However, the Appellant's application provides that:

The cross-sectional shape of the passageway 25, or the shape of either or both the inlet opening 23 and outlet opening 24, can be circular, or can be preferably oval or elliptical. It has been found that an outlet opening and at least a portion of the passageway that are oval or elliptical can accommodate the human hand more readily than a circular shape.

(Application page 3, lines 99-102).

Although caselaw provides that "matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

invention from the prior art." MPEP § 2144.04 (I) (citing *In re Seid*, 161 F.2d 229, 73, USPQ 431 (CCPA 1947)). Because the claimed shape of the outlet and portion of the passageway provides facilitated use of the portable packaging device of the claimed invention, the shape of the outlet opening and portion of the passageway has a mechanical function. Therefore, the shape of the outlet opening and portion of the passageway are not *de facto* obvious. Consequently, the conclusory statement provided by the Office that the shape of the outlet end and portion of the passageway is mere design choice and is therefore obvious does not meet the initial burden on the Office for establishing a proper or sufficient rejection based on § 103.

2. The Office has used incorrect sources in supporting its rationale for a rejection under § 103.

The MPEP provides that "[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art." MPEP § 2144 at 134. "The rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law." *Id.*

The MPEP makes no mention of using the application of the Appellant as a source for rationale to modify the prior art. However, as provided above, the Office states that simply because the Appellant submitted that the inlet and outlet openings can be either circular or oval that an oval shaped outlet opening is therefore an obvious variation. The Office has not provided any support for its conclusion of obviousness except the application of the Appellant. Consequently, the Office has not supported its rejection of claim 10 under § 103.

3. There is no motivation to combine the cited references because the cited references teach away from the suggested combination.

The arguments asserted in section I.A.1., with regard to claims 1 and 6-9, are equally applicable to the rejection of claim 10. Namely, there is no motivation to make the suggested combination because Richards teaches away from a combination with Meissner and also teaches away from a combination with Hamilton. Therefore, there is

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

no motivation to combine the suggested references. Consequently, a *prima facie* case of obviousness has not been established against claim 10.

4. There is no motivation to combine the cited references because the suggested combination of references would render the primary reference unsatisfactory for its intended purpose.

The arguments asserted in section I.A.2., with regard to claims 1 and 6-9, are equally applicable to the rejection of claim 10. Namely, the proposed combination of Richards and Meissner would render Richard unsatisfactory for its intended purpose. Consequently, a *prima facie* case of obviousness has not been established against claim 10.

5. The combination of cited references fail to teach or suggest all of the claim limitations of the claimed invention.
- a. Suggested combination does not teach a cutting blade is "positioned adjacent the outlet opening of the inner core, for cutting through a trailing portion of the tubular film to form the closed packaged article".

The arguments asserted in section I.A.3., with regard to claims 1 and 6-9, are equally applicable to the rejection of claim 10. Namely, the proposed combination of Richards, Meissner, and Hamilton do not teach or suggest all of the claim elements of claim 10. Specifically, the suggested combination fails to teach or suggest that a cutting blade is "positioned adjacent the outlet opening of the inner core, for cutting through a trailing portion of the tubular film to form the closed packaged article," as recited, in part, in claim 10.

- b. Suggested combination does not teach a shape of "the outlet opening and a portion of the passageway are oval or elliptical."

Claim 10, recites, in part, that the shape of the outlet opening and a portion of the passageway are oval or elliptical." As discussed with regard to section II.A.1., the oval or elliptical shape of the outlet opening and portion of the passageway facilitates the use of the portable packaging device of the claimed invention. The shape of the outlet opening and portion of the passageway is not merely ornamental and is not without mechanical

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

functionality. Therefore, the oval or elliptical shape of the outlet opening and portion of the passageway can be relied upon to patentably distinguish the claimed invention from the prior art.

As provided by the Office, Richards does not teach or suggest an outlet opening or portion of the passageway which is oval or elliptical. In addition, neither Hamilton nor Meissner teach or suggest that the outlet opening or portion of the passageway is oval or elliptical as well. Consequently, the suggested combination of Richards, Hamilton, and Meissner fails to teach or suggest all of the claim elements of claim 10.

B. The Office has failed to establish a by a preponderance of the evidence that a *prima facie* case of obviousness is more probable than not.


The arguments asserted in section I.B., with regard to claims 1 and 6-9 are equally applicable to the rejection of claim 10. Namely, there is no motivation to combine the suggested references because Richards teaches away from the suggested combination. Furthermore, the suggested combination of references would render Richards unsatisfactory for its intended purpose. Also, the suggested combination of documents fails to teach or suggest all of the claim limitations of claim 10. Therefore, the Office has failed to establish a *prima facie* case of obviousness. Consequently, the Office has not shown by a preponderance of evidence that a *prima facie* case of obviousness is more probable than not.

SUMMARY

The Federal Circuit has stated that "[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d at 1446. In view of all of the above, it is respectfully submitted that claims 1 and 6-10 have not been properly rejected under 35 U.S.C. § 103(a) because the Office has failed to establish a *prima facie* case of obviousness. Therefore, in light of all of the analysis and discussion provided above, Appellant respectfully request the Board of Patent Appeals and Interferences to reverse the rejections of claims 1 and 6-10 and to remand the application with instructions that these claims be allowed over the cited documents.

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY



Signature
Jay A. Krebs

Registration No. 41,914
(513) 634-4856

Date: March 31, 2005

Customer No. 27752

(AppealBrief.doc)
Revised 11/5/2004

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

CLAIMS APPENDIX

1. (Rejected) A portable packaging device for individually packaging an article within a flexible tubular sheet, the device having an inlet end and an outlet end, and comprising:

a body formed by an inner core having an inlet opening and an outlet opening, and a passageway there between for passing there through an article to be packaged,

a casing comprising a surrounding casing wall, and a base wall that joins an end of the surrounding casing wall to the body, the body and the casing defining a storage space and a dispensing opening at the inlet end, wherein the device retains a length of a flexible tubular sheet within the storage space, wherein the tubular sheet is dispensed through the dispensing opening and into the inlet opening of the inner core, the article to be packaged is inserted through the inlet opening, and inside the tubular sheet, the tubular sheet is gathered and closed at each end to form a closed packaged article and the tubular sheet has an outer surface, the outer surface facing inward when the tubular sheet is passed through the inner core, the outer surface comprising an adhesive material, whereby a leading portion and a trailing portion of the tubular sheet are closeable on each side of article with the adhesive material, thereby forming the closed packaged article, and

a cutting blade positioned adjacent the outlet opening of the inner core, for cutting through a trailing portion of the tubular film to form the closed packaged article.

2-5. Cancelled

6. (Rejected) The portable packaging device according to Claim 1 wherein the tubular sheet comprises a three-dimensional film having an outer surface that comprises a plurality of recessed pressure sensitive adhesive sites and a plurality of collapsible protrusions that serve as stand-offs to prevent premature sticking of the adhesive sites to a target surface until a force sufficient to collapse the protrusions has been applied to the opposed surface of the film.

7. (Rejected) The package device according to Claim 6, wherein the article to be packaged is a waste-filled disposable absorbent article.

Appl. No. 09/745,702
Atty. Docket No. 8334
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

8. (Rejected) The portable packaging device according to Claim 1, further comprising a cap covering at least a portion of the dispensing opening for retaining the length of the flexible tubular sheet.

9. (Rejected) The packaging device according to Claim 1, further comprising a handle to facilitate holding and carrying the device.

10. (Rejected) A portable packaging device for individually packaging an article within a flexible tubular sheet, the device having an inlet end and an outlet end, and comprising:

a body formed by an inner core having an inlet opening and an outlet opening, and a passageway there between for passing there through an article to be packaged,

a casing comprising a surrounding casing wall, and an base wall that joins an end of the surrounding casing wall to the body, the body and the casing defining a storage space and a dispensing opening at the inlet end, wherein the device retains a length of a flexible tubular sheet within the storage space, wherein the tubular sheet is dispensed through the dispensing opening and into the inlet opening of the inner core the article to be packaged is inserted through the inlet opening and inside the tubular sheet, the tubular sheet is gathered and closed at each end to form a closed packaged article and the tubular sheet has an outer surface, the outer surface facing inward when the tubular sheet is passed through the inner core, the outer surface comprising an adhesive material, whereby a leading portion and a trailing portion of the tubular sheet are closeable on each side of article with the adhesive material, thereby forming the closed packaged article, and wherein the shape of the outlet opening and a portion of the passageway are oval or elliptical; and

a cutting blade positioned adjacent the outlet opening of the inner core, for cutting through the trailing portion of the tubular film to form the closed packaged article.

11. Cancelled.

12. (Withdrawn) A method for manually forming a closed individually packaged article from a tubular sheet, comprising the steps of:

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

- a. providing a portable packaging device having an inlet end and an outlet end, comprising:
 - i) a body formed by an inner core having an inlet opening and an outlet opening, and a passageway there between for passing there through an article to be packaged, and
 - ii) a casing comprising a surrounding casing wall, and an base wall that joins an end of the surrounding casing wall to the body, the body and the surrounding casing wall defining a storage space and a dispensing opening at the inlet end,
- b. providing a length of flexible tubular sheet retained within the storage space, the tubular sheet having a leading edge and a trailing portion that follows the leading edge,
- c. dispensing the leading edge from the storage space through the dispensing opening and the inlet opening, and into the passageway of the inner core,
- d. gathering and closing the leading edge, thereby forming with the trailing portion a receiving pouch within the passageway of the inner core,
- e. inserting an article to be packaged by a user of the device into the receiving pouch,
- f. gathering the trailing portion behind the article, thereby forming an individually packaged article,
- g. closing the gathered trailing portion, and
- h. separating the closed individually packaged article from a further trailing portion of the tubular sheet at the closed gathered trailing portion.

13. (Withdrawn) The method of Claim 12, wherein the step f of gathering the trailing portion of the tubular sheet comprises inserting the users hand through the outlet opening and into the passageway, and grasping by hand and twisting the individually packaged article.

14. (Withdrawn) The method of Claim 12, wherein the step h of separating the closed individually packaged article comprises cutting through the closed gathered trailing portion.

Appl. No. 09/745,702
Atty. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

15. (Withdrawn) The method of Claim 12, wherein the step h of separating comprises pulling apart or tearing the tubular sheet, one portion from another, along a separable region within the tubular sheet.

16. (Withdrawn) The method of Claim 12, wherein the tubular sheet provided in step b has an outer surface facing inward when the tubular sheet is positioned inside the passageway, the outer surface comprising an adhesive material, whereby closing the leading edge of step d and the gathered trailing portion in step g comprises closing with the adhesive material.

17. (Withdrawn) The method of claim 16 wherein the tubular sheet comprises a three-dimensional film sheet, the inside surface comprising a plurality of recessed pressure sensitive adhesive sites and a plurality of collapsible protrusions which serve as stand-offs to prevent premature sticking of the adhesive sites to a target surface until a force sufficient to collapse the protrusions has been applied to the opposed surface of the film.

18. (Withdrawn) The method of Claim 17, wherein the closed individually packaged article can maintain a seal at an ambient temperature of 35°C with an internal differential pressure of +26 mm Hg.

19. (Withdrawn) An apparatus for forming a pleated layered pack of tubular sheet from a length of flexible tubular sheet material and having an inner surface, comprising:

- a) a central mandrel having a film receiving end and a base end, an external circumference determined by an internal diameter for each layered pack, and a plurality of slots positioned circumferentially around the central mandrel and extending axially from the base end and ending toward the film receiving end,
- b) a base positioned at the base end of the central mandrel,
- c) a means for feeding the tubular film onto the central mandrel in pleated layers, comprising
 - i) an engaging means registered with each slot, having an extended position extending through the slot to contact the inner surface of the tubular film, and a retracted position within the central mandrel,

Appl. No. 09/745,702
Auy. Docket No. 8384
Appeal Brief Dated March 31, 2005
Appeal of Final Office Action of November 1, 2004
Customer No. 27752

- ii) an extending means for moving the engaging means radially between the extended position and the retracted position,
- iii) a reciprocating means for moving the engaging means axially between a pickup position near the film receiving end of the slot, and a deposit position toward the base end, and
- iv) a drive means for driving the extending means and the reciprocating means in synchronized timing, wherein the engaging means proceeds through a cycle of:
 - a) the extended position at the pickup position, thereby engaging the inner surface of the tubular film,
 - b) the extended position at the deposit position, thereby pulling the tubular film down to form a pleated layer,
 - c) the retracted position at the deposit position, thereby disengaging from the inner surface of the pleated tubular film, and
 - d) the retracted position at the pickup, thereby returning to the beginning of the cycle,

thereby forming the pleated layered pack of tubular sheet.

20. (Withdrawn) The apparatus according to claim 19, further comprising an indexing means whereby the distance between the pickup position and the deposit position is maintained substantially constant.